



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/754,519

01/04/2001

Noboru Shibuya

275738US6

4153

22850

7590

03/31/2009

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

HENNING, MATTHEW T

ART UNIT

PAPER NUMBER

2431

NOTIFICATION DATE

DELIVERY MODE

03/31/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary	Application No. 09/754,519	Applicant(s) SHIBUYA ET AL.	
	Examiner MATTHEW T. HENNING	Art Unit 2431	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12 and 15-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12 and 15-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 January 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1 This action is in response to the communication filed on 3/16/2009.

2 **DETAILED ACTION**

3
4 ***Response to Arguments***

5 Applicant's arguments filed 3/16/2009 have been fully considered but they are not
6 persuasive.

7 The newly added claim limitations have been addressed below.

8 All objections and rejections not set forth below have been withdrawn.

9 Claims 12, and 15-24 have been examined and Claim 1-11, and 13-14 have been
10 cancelled.

11 ***Drawings***

12 The drawings are objected to under 37 CFR 1.83(a). The drawings must show every
13 feature of the invention specified in the claims. Therefore, the transferring copyrighted music
14 data to the external storage card even if power of said central processing unit is turned off must
15 be shown or the feature(s) canceled from the claim(s). **No new matter should be entered.**

16 Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to
17 the Office action to avoid abandonment of the application. Any amended replacement drawing
18 sheet should include all of the figures appearing on the immediate prior version of the sheet,
19 even if only one figure is being amended. The figure or figure number of an amended drawing
20 should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure
21 must be removed from the replacement sheet, and where necessary, the remaining figures must
22 be renumbered and appropriate changes made to the brief description of the several views of the

Art Unit: 2431

drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: In this case, the newly claimed limitation of "transferring copyrighted music data to the external storage card even if power of said central processing unit is turned off" lacks support in the specification as originally filed. See the rejection of the claims under 35 USC 112 1st Paragraph below.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 12, and 15-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In this case, the newly added claim limitation reciting "transferring

Art Unit: 2431

1 copyrighted music data to the external storage card even if power of said central processing unit
2 is turned off" appears to lack support in the original specification. The applicant's have pointed
3 to portions of the specification as showing support for this limitation. However, in these
4 sections, as well as the remainder of the specification, the examiner is only able to find support
5 for reproducing (i.e. playing) music content when the CPU is not powered. Further, the
6 applicants have pointed to "original claim 15". The examiner points out that there is no "original
7 claim 15" in this application as the original application only contained 9 claims. Further,
8 previously presented claim 15, which cannot be relied upon as providing support for this new
9 limitation, again only shows reproduction of the music data, and not storing music data to the
10 memory card. Therefore, because the applicants have failed to show proper support for the
11 newly claimed subject matter, and the examiner is unable to find such support in the
12 specification as originally filed, one of ordinary skill in the art would not be able to determine
13 whether the applicants were in possession of the invention as claimed at the time of application.
14 Therefore, the claims are rejected for failing to meet the written description requirement of 35
15 USC 112 1st Paragraph.

16
17 ***Claim Rejections - 35 USC § 103***

18 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
19 obviousness rejections set forth in this Office action:

20 *A patent may not be obtained though the invention is not identically disclosed or*
21 *described as set forth in section 102 of this title, if the differences between the subject*
22 *matter sought to be patented and the prior art are such that the subject matter as a*
23 *whole would have been obvious at the time the invention was made to a person having*
24 *ordinary skill in the art to which said subject matter pertains. Patentability shall not be*
25 *negated by the manner in which the invention was made.*

1
2 Claims 12, 14-19, and 21-22, are rejected under 35 U.S.C. 103(a) as being unpatentable
3 over Tatebayashi et al. (U.S. Patent Number 6,859,535) hereinafter referred to as Tate, and
4 further in view of Chan et al. (US Patent Number 6,226,237) hereinafter referred to as Chan.

5 Regarding claim 12, Tate disclosed a general-purpose computer having a central
6 processing unit which can decode data stored in an internal storage mechanism as instructed by a
7 program stored in said internal storage mechanism (See Tate Col. 8 Lines 31-51), comprising: a
8 loading mechanism, which is integrally arranged on a case of said general-purpose computer, for
9 detachably accommodating an external storage card (See Tate Fig. 2 Elements 501 and 300; note
10 that Tatebayashi teaches that the memory card reader 400 and the memory card writer 300 can be
11 one in the same, as can be seen in Tatebayashi Col. 51 Line 64 – Col. 52 Line 11); a decoding
12 mechanism configured to decode data read from said external storage card (See Tate Col. 8 Lines
13 31-51 and Fig. 6 Element 460); a reproduction mechanism configured to reproduce decoded data
14 decoded by said decoding mechanism (See Col. 8 Lines 31-51); and said loading mechanism is
15 configured to read said decoded data based on commands from said central processing unit when
16 said general-purpose computer is in an active state (See Tate Col. 52 Paragraph 1), and a cross-
17 authentication mechanism configured to cross-authenticate said external storage card through
18 said loading mechanism (See Tate Col. 11 Lines 3-20); and a control mechanism for supplying
19 copyrighted data read from said external storage card to said reproducing mechanism upon
20 successful cross-authentication by said cross- authentication mechanism (See Col. 8 Lines 44-
21 51), when said external storage card has been cross-authenticated with said general-purpose
22 computer, an external storage card control mechanism plays copyrighted music data on a

1 portable music playing device by connecting said external storage card to said portable music
2 playing device (See Tate Col. 8 lines 44-51), but failed to disclose a power controller that
3 supplies power to said general-purpose computer, wherein said power controller supplies power
4 to said decoding mechanism and said reproduction mechanism even if power of said central
5 processing unit is turned off, and said loading mechanism is configured to read said decoded data
6 based on commands from an external storage card control mechanism integrally arranged on said
7 case of said general-purpose computer, without control of a central processing unit when said
8 general-purpose computer is in an inactive state, or wherein said power controller supplies power
9 to said cross-authentication mechanism and said control mechanism even if power of said central
10 processing unit is turned off and an external storage card control mechanism transfers
11 copyrighted music data to said external storage card even if power of said central processing unit
12 is turned off.

13 Chan teaches that when computers reproduce audio from an external device, much of the
14 power consumed by the computer is in peripherals not actually being used (See Chan Col. 1
15 Lines 29-37), and that unused portions of the computer, including the CPU, can be powered off
16 (un-energized), and when the CPU is energized the CPU will control the audio playback
17 commands, but when the CPU is not energized, an audio sub-system (106) should remain
18 energized to control the playback of the audio without use of the CPU (See Chan Col. 8
19 Paragraphs 2-3). Chan further teaches the implementation of such a system utilizes an audio
20 subsystem (106) which includes a power controller that supplies power to said general-purpose
21 computer, wherein said power controller supplies power to said decoding mechanism and said
22 reproduction mechanism even if power of said central processing unit is turned off (See Chan

Art Unit: 2431

1 Col. 8 Paragraphs 2-3: wherein the "computer subsystem 104", which includes the CPU as can
2 be seen in Fig. 1, is not energized), and said loading mechanism is configured to read audio data
3 based on commands from an external storage card control mechanism of said general-purpose
4 computer, without control of a central processing unit when said general-purpose computer is in
5 an inactive state (See Chan Col. 10 Line 48 – Col. 11 Line 58), or wherein said power controller
6 supplies power to said cross-authentication mechanism and said control mechanism even if
7 power of said central processing unit is turned off (See Chan Col. 8 Paragraphs 2-3: wherein the
8 "computer subsystem 104", which includes the CPU as can be seen in Fig. 1, is not energized).

9 Chan further teaches that the audio sub-system allows the selection and control of music
10 being played without powering on the CPU (See Chan Col. 3 Lines 37-40).

11 Chan further teaches that the audio sub-system 106 should have a track number display
12 and an Icon LCD which the audio subsystem uses to indicate operation (See Chan Col. 6 Lines
13 52-58).

14 It would have been obvious to the ordinary person skilled in the art at the time of
15 invention to employ the teachings of Chan within the audio reproduction system of Tate by
16 incorporating the audio subsystem 106 of Chan within the computer system 500 of Tate in order
17 to shut off the power to the idle personal computer while reading and reproducing music data
18 from the external medium by the content player subsystem, or by reading and reproducing the
19 data from the external medium by the content player subsystem without powering on the CPU,
20 and having a display configured to display operating characteristics of the audio device when the
21 computer is idle. This would have been obvious because the ordinary person skilled in the art
22 would have been motivated to reduce the power consumed by the system. It further would have

Art Unit: 2431

1 been obvious to the ordinary person skilled in the art at the time of invention to have employed
2 the teachings of Chan by including control buttons in the audio subsystem. This would have
3 been obvious because the ordinary person skilled in the art would have been motivated to
4 provide a means for controlling the playback of the audio by the audio subsystem.

5 In this combination it would have been obvious to the ordinary person skilled in the art at
6 the time of invention that the CD-ROM Drive 138 of Chan would be replaced with the memory
7 card reader/writer 300 and memory card writer slot 501 of Tatebayashi (which is integrally
8 arranged on the case of the personal computer 500 as can be seen in Fig. 2 of Tatebayashi)
9 within the audio subsystem 106, and to have allowed full functionality of the reader/writer when
10 the CPU was not powered, including writing music data to the memory card (Tatebayashi Col. 8
11 Lines 44-48). This would have been obvious because the ordinary person skilled in the art
12 would have recognized that the preferred audio system of Tatebayashi was the memory card
13 reader/writer, and not a CD-ROM drive.

14 In this combination it further would have been obvious to the ordinary person skilled in
15 the art to have energized the card reader/writer and its components, including the mutual
16 authentication unit, while the CPU of the personal computer and other components, which as
17 taught by Chan are not essential to the content reproduction, are not energized. This would have
18 been obvious because the ordinary person skilled in the art would have been motivated to
19 conserve energy while allowing for audio reproduction.

20 Regarding claim 15, Tate and Chan disclosed that in an inactive state in which no electric
21 power is supplied to said general-purpose computer, an external storage card control mechanism

1 reads copyrighted data from said external storage card and supplies said copyrighted data to a
2 portable music playing device (See Tate Col. 8 Lines 44-51 and the rejection of claim 12 above).

3 Regarding claim 16, see the rejection of claim 12 above.

4 Regarding claim 17, Tate and Chan disclosed that a function equivalent to a portable
5 music playing device is realized by executing, by a controller of said general-purpose computer,
6 a program stored in said internal storage mechanism of said general-purpose computer (See Tate
7 Col. 1 Lines 29-37 and Col. 8 Lines 31-51 and col. 52 Paragraph 1).

8 Regarding claim 18, Tate and Chan disclosed that said internal storage mechanism is a
9 hard drive (See Tate Lines 31-34).

10 Regarding claim 19, Tate and Chan disclosed that said copyrighted data is encrypted
11 copyrighted data (See Tate Abstract).

12 Regarding claim 21, Tate and Chan taught that said external storage card mechanism has
13 programmable power key functionality (See Chan Col. 11 Lines 55-58).

14 Regarding claim 22, Tate and Chan taught that said loading mechanism is located on a
15 side of a case enclosing a monitor for said general-purpose computer (Tate Fig. 2 Element 501).

16 Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination
17 of Tate and Chan as applied to claim 12 above, and further in view of Schneier (Applied
18 Cryptography Second Edition).

19 Regarding claim 20, Tate and Chan disclosed that when said external storage card control
20 mechanism is operated and said central processing unit is in said inactive state, the audio
21 subsystem enters an initialize state (See Chan Col. 11 Lines 55-58), and in the initialize state, the
22 audio subsystem causes the audio player to play (See Chan Col. 10 Lines 56-67). However, Tate

1 and Chan failed to specifically disclose that in this case "a predetermined software program is
2 executed".

3 Tate did, however, disclosed that in order to reproduce the encrypted content, the
4 memory card reader and decrypts the encrypted content (See Tate Fig. 8), but Tate is silent as to
5 whether the decryption process is performed using a software program, or whether it was
6 performed using only hardware. Tate did disclose that the decryption occurs in the memory card
7 reader and that the decryption algorithm was pre-stored in the decryption unit (See Tate Col. 10
8 Lines 23-29 and Col. 16 Lines 49-64 and Col. 14 Lines 14-20).

9 Schneier teaches that any encryption algorithm can be implemented in software, and that
10 the advantages of doing so are in flexibility and portability, ease of use, and ease of upgrade (See
11 Schneier Page 225).

12 It would have been obvious to the ordinary person skilled in the art at the time of
13 invention to have employed the teachings of Schneier in the content reproduction system of Tate
14 and Chan, by implementing the pre-stored decryption algorithm in software. This would have
15 been obvious because the ordinary person skilled in the art would have been motivated to
16 provide the decryption with flexibility and portability, ease of use, and ease of upgrade.

17 Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination
18 of Tate and Chan as applied to claim 12 above, and further in view of Jones et al. (US Patent
19 Number 6,697,944) hereinafter referred to as Jones.

20 While Tate and Chan taught providing power to the detachable portable reader/writer,
21 Tate and Chan failed to specifically teach providing the power via a USB cable.

Jones teaches that USB cables can be used for providing data connections as well as power for battery powered portable devices (Jones Col. 9 Lines 34-52).

It would have been obvious to the ordinary person skilled in the art at the time of invention to have employed the teachings of Jones in the portable device system of Tate and Chan by providing the data and power connection to the reader/writer via a USB cable. This would have been obvious because the ordinary person skilled in the art would have been motivated to provide a specific means to the generic power providing of Tate and Chan.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Tate and Chan as applied to claim 12 above, and further in view of Boothroyd et al. (US Patent Number 5,267,123) hereinafter referred to as Boothroyd.

While Tate and Chan did teach a display, Tate and Chan failed to specifically teach a display located on a top side of a case enclosing a monitor for said general purpose computer, said display being visible even when said top said of said case is closed.

Boothroyd teaches a display which is located on a case and is visible when the lid of the case is closed (See Boothroyd Col. 1 Lines 26-31).

It would have been obvious to the ordinary person skilled in the art at the time of invention to employ the teachings of Boothroyd in the computer system of Tate and Chan by incorporating the pivotal display of Boothroyd in the computer. This would have been obvious because the ordinary person skilled in the art would have been motivated to have the screen be accessible when the computer lid is closed and protecting the keyboard.

Conclusion

Claims 12, 14-24 have been rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW T. HENNING whose telephone number is (571)272-3790. The examiner can normally be reached on M-F 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew T Henning/
Examiner, Art Unit 2431